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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,158	11/15/2001	Jeffrey D. Kenyon	020366-086100US	3861

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EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,158

Applicant(s)

KENYON, JEFFREY D.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Specification

1. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 13-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The Applicant is claiming program product in a computer readable medium. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature that constitute "descriptive material." Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs that impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support

specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir.1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.") (quoted with approval in *Abele*, 684 F.2d at 907, 214 USPQ at 687). See also *In re Johnson*, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component and it does not become statutory by

merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-5, 8-16 and 18-21 are rejected under 35 USC 102(e) as being anticipated by Tarvydas et al. (patent application number 2002/0038255 hereinafter referred to as "Tarvydas").**

Tarvydas teaches all the limitations of Claims 1-5, 8-16 and 18-21. For example, Tarvydas discloses a universal shopping cart (USC) that obtains and orders products and services from different merchants located on the Internet (see at least abstract; Fig. 2 (200); page 1, paragraph 0008). Tarvydas further discloses:

- Accessing the information items at a website: consumer accesses shopping site using a web browser via the Internet; consumer searches item database; uniquely identifies item SKU and merchant associated with the item and item characteristics and detail descriptions (see at least Fig.

7 (704); Fig. 8 (805); Fig. 9 (900); page 5, 0052, 0055); file name box displayed on user device (e.g. username) (see at least Fig. 15 (1500); page 7, 0069).

- Placing the information items in an information shopping cart at the website: consumer selects products and places selected items in USC (see at least Fig. 7 (720, 728); page 5, 0052).
- Transmitting the information shopping cart having the selected information items to a portable device: consumer device (see at least Fig. 2 (300); Fig. 3 (300); Fig. 7 (300); page 3, 0041); wireless PDA as consumer device (see at least pages 3-4, 0041-42); interacting with USC using wireless PDA or other wireless device (see at least pages 5-6, 0056).
- Directory website: electronic commerce server accesses merchant servers for requested information (please note examiner's interpretation: electronic commerce server provides directory functionality by finding which merchant possesses information requested by consumer (see at least Fig. 7 (400); Fig. 9 (900); pages 3-4, 0042, 0045-0046); Branding information identifies InfoSpace.Com via logo as operator of the electronic commerce website; branding information identifies merchant (e.g. Barnes & Nobels; Borders.com) (see at least Fig. 9 (900); Fig. 12 (1200); pages 6-7, 0064).
- Formats: HTML, Handheld Device Markup Language (HDML), Wireless Markup Language (WML), microbrowsers, UP.link (see at least page 6, 0056).

Pertaining to website Claims 13-16 and 18-21

Rejection of Claims 13-16 and 18-21 is based on similar rationale as noted above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 6 is rejected under 35 USC 103(a) as being unpatentable over Tarvydas (patent application number 2002/0038255), in view of Official Notice (regarding screen names).**

Tarvydas teaches all the above as noted under the 102(e) rejection and teaches a) consumer usernames for user login purposes to access USC and account file information, and b) transmitting information to a wireless PDA, but does not disclose displaying the username to the PDA. This examiner takes the position that it is old and well-known to one of ordinary skill in the art to display usernames to a user's device to associate the username with a file or user account. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Tarvydas to display the username to the user's device as taught by Official Notice, in order to convey to the user a file or account associated with the user.

5. **Claims 7 and 17 are rejected under 35 USC 103(a) as being unpatentable over Tarvydas (patent application number 2002/0038255), in view of Communications Today (PTO-892, Item: U hereinafter referred to as "CT").**

Tarvydas teaches all the above as noted under the 102(e) rejection and teaches a) wireless users viewing transmitted information from the web site via various formats (e.g. HDML, WML, microbrowsers), and b) users interacting with the USC from a wireless device, but does not disclose the user selecting the format. CT teaches a wireless Internet service that allows users to choose from four display screen formats as their starting point for browsing the wireless Web (U: see at least page 1). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Tarvydas to allow users to select a screen format as taught by CT, in order to accommodate consumer preferences, and thereby attract consumers to the commerce service.

Tarvydas and CT teach all the above as noted under the 103(a) rejection and teach a) web browser boxes for user input (see at least Fig. 15 (1500)), and b) users selecting a screen format for their wireless device, but do not disclose how the user selects the screen format. It would have been obvious to one of ordinary skill in the art at time of the invention to display an input box for the consumer to collect screen format selection, since it is well within the skill to ascertain that an input box is used to collect information.

Pertaining to website Claim 17

Rejection of Claim 17 is based on similar rationale as noted above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- PR Newswire; "InfoSpace Reports Record Second Quarter Results and Announces Plans to Acquire Leading Broadband Infrastructure Company Go2Net," 26 July 2000, 14pgs, Proquest #56981227; teaches wireless electronic commerce using personal digital assistants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Vincent Millin** can be reached on 703-308-1065.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

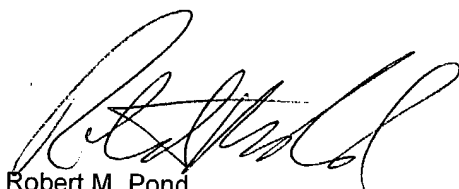
Washington D.C. 20231

or faxed to:

Art Unit: 3625

703-872-9306 (Official communications; including After Final
communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA, 7th floor receptionist.

A handwritten signature in black ink, appearing to read 'R. M. Pond', written in a cursive style.

Robert M. Pond
Patent Examiner
June 24, 2004